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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,029	07/25/2001	Guy W. Feldten	51430-00210	7044

30638 7590 09/15/2005

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EXAMINER

STERRETT, JONATHAN G

ART UNIT PAPER NUMBER

3623

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/915,029	<b>Applicant(s)</b> FELDTEN, GUY W.	
	<b>Examiner</b> Jonathan G. Sterrett	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-25-01</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Summary*

1. **Claims 1-15** are pending in the application.

### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-15** are rejected under 35 U.S.C. 101 because the invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts: and
- (2) whether the invention produces a useful, concrete and tangible result.

6. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, none of **Claims 1-15** are directed to anything in the technological arts as explained above. Specifically for **Claim 1**, the limitation "**said database containing for each person (a) the person's**

Art Unit: 3623

**name and contact information**" is cited. This limitation can be performed manually without utilizing technological elements, for example, by storing a person's name and contact information in a paper card file (e.g. rolodex). Further in **Claim 1**, the limitation "**entry by a test screening member of his or her identification number and access code, to thereby obtain access...to said video under screen testing**" is cited. These limitations can be performed manually without utilizing technological elements. Looking at the claims as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer or any technology performs the recited steps. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention provides for providing feedback from screening videos, which is a useful, concrete and tangible result. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, **Claims 1-15** are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3623

8. **Claims 1-9, 11-13 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Herz US 6,088,722** in view of **Von Kohorn US 2001/0003099**.

Regarding **Claim 1**, Herz teaches:

**(i) establishing a registrant database of persons who volunteer to serve as a member of a test screening audience for video test screening on said network, said registrant database containing for each said person,**

**(a) the person's name and personal contact information, and**

**(b) the person's identification number called an ID number,**

Column 4 line 25-29, customers volunteer to develop an 'agreement matrix' characterizing the video program's attractiveness on a television network.

Column 25 line 64-65, a registrant database of customer profiles. These customer profiles are used to reflect a customer's viewing preferences, these preferences are obtained through a customer rating a program.

Column 27 line 17-22, the system provides for a customer to identify themselves by entering a user ID (i.e. ID number).

**(ii) establishing a test screening audience database of test screening audience members for test screening a particular specific video,**

Art Unit: 3623

**(a) wherein said test screening audience members are selected from persons in said registrant database by a procedure involving one more of the following techniques:**

**A. selection without regard to the time a person was added to said registrant database,**

**B. sequential selection in the order in which a person volunteered to serve as member of test screening audience for said particular specific video,**

Column 13 line 31, a sample group of test screening audience members is established. This audience is for test screening a particular specific video program.

Column 35 line 5-10, customers are selected without regard to the time a person was added to the database – e.g. through clustering customers through demographics.

**(iii) conducting test screening of said particular specific video on said network by steps involving**

**(a) entry by a test screening audience member of his or her identification number, to thereby obtain access by said test screening audience member to the particular specific video under screen testing, and**

Art Unit: 3623

Column 27 line 17-22, the system provides for a customer to identify themselves by entering a user ID (i.e. ID number) – see also Figure 9 #918 'user identifier'. This provides for the system to identify that particular viewer.

Column 13 line 35-41, profiles of those who have viewed a program during the test screening, as established by entering their ID number, is used to provide a combined profile rating to that video prior to broadcast over the network.

**(b) providing on-line responses by test screening audience members to questions about the video of the test screening.**

Column 13 line 25-27, audience members test screening the videos provide online responses – see figure 9, the responses are returned back to the provider of video programs through telco systems (i.e. online).

Herz does not teach:

**(i) Establishing a registrant database with the person's name and contact information.**

**Using access codes along with an customer ID to:**

**(ii) (b) wherein said test screening audience database is limited to members who accept assignment to them of a special access code to be entered by said member together with the member's**

Art Unit: 3623

**identification number in order to gain access to the particular specific video test screening on said network.**

**(iii) conducting test screening of said particular specific video on said network by steps involving.**

**(a) entry by a test screening audience member of his or her access code, to thereby obtain access by said test screening audience member to the particular specific video under screen testing, and**

Von Kohorn teaches:

**Using an ID number and access number to provide secure access for a viewer of a video.**

Paragraph 512 line 4-9, a person's ID number and PIN number (i.e. access number ensures a person is identified positively when viewing a video performance – see also Figure 29 #1020 “Numb. Indent” and #908 “P.I.N. Authorization”.

Von Kohorn teaches that using a PIN in addition to a identification number provides additional security to ensure authorization for a person (paragraph 512 line 7-8).

Von Kohorn and Herz both address the broadcasting and viewer feedback of video programming, thus both Von Kohorn and Herz are analogous art.



It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Herz, regarding providing test screening of videos to members of a screening audience as identified by an identification number, to include the step of providing access through a customer ID number and PIN, as taught by Von Kohorn, because it would provide an additional level of security to ensure the remote viewer is the person as identified by their customer number.

Herz also does not teach the database containing contact information for the viewers.

Von Kohorn teaches tabulating contact information for the viewers to provide for follow up with the viewers as needed (paragraph 632 line 6-9, viewers can be followed up by telephone, mail or visits).

Von Kohorn teaches that tabulating contact information allows specific viewers to be contacted later, depending on their feedback.

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the teachings of Herz, regarding maintaining a database for viewers, to include the step of maintaining contact information in the

Art Unit: 3623

database, as taught by Von Kohorn, because it would allow follow up contact with the viewers as needed depending on their feedback from viewing a video.

Regarding **Claim 2**, Herz teaches obtaining feedback from a target audience on a video that has not been seen before (column 14 line 24-27).

Herz does not teach publishing an announcement such **that any person desiring to serve as a member of a video test screening audience on said network should volunteer for such service.**

However Official Notice is taken that publishing announcements to the general public to secure volunteers for market testing is old and well known in the art. Volunteers are solicited so that a sample population of the public can be established from which to extract feedback of a product to be marketed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Herz regarding conducting test screenings of videos to obtain customer feedback, to include the step of publishing an announcement to solicit volunteers for video test screening, because it would provide a way to obtain customer feedback from the general public to evaluate whether a video to be screened would be successful.

Art Unit: 3623

Regarding **Claim 3**, Herz teaches obtaining feedback from a target audience on a video that has not been seen before (column 14 line 24-27).

Herz does not teach publishing an announcement such that **any person desiring to serve as a member of a test screening audience on said network for said particular specific video should volunteer for such service.**

However Official Notice is taken that publishing announcements to the general public to secure volunteers for market testing is old and well known in the art. These serve to obtain feedback from customers in such a way to determine if the product is likely to be a success.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Herz regarding conducting test screenings of videos to obtain customer feedback, to include the step of publishing an announcement to solicit volunteers for video test screening, including for a particular video, because it would provide a way to obtain customer feedback from the general public to evaluate whether the specific video would be successful.

Regarding **Claim 4**, Herz teaches:

**the further step of adding demographic information for persons in said registrant database.**

Art Unit: 3623

Column 25 line 64-65, a registrant database of customer profiles. These customer profiles are used to reflect a customer's viewing preferences, these preferences are obtained either directly through a customer rating a program or passively based on what they watch. As noted in Column 39, the profiles may be updated to include demographic information.

column 39 line 5-8, demographic information is added to individual customer profiles in the database.

Regarding **Claim 5**, Herz teaches:

**the additional step pre-establishing demographic requirements for said members said test screening audience for said particular specific video, and wherein selection said members of said test screening audience is from persons whose demographics satisfy said demographic requirements.**

Column 35 line 24-28, clusters of viewers (i.e. clustering based on demographic information –see line 17-21, clustering based on demographics) are formed based on the types of programs viewers watch.

Column 41 line 18-19, individual members in a cluster (based on predetermined demographics) can be requested to rate a particular video to obtain the profile for that cluster based on the demographics.

Regarding **Claim 6**, Herz teaches:

Art Unit: 3623

**the step of establishing, before establishing said test screening audience database, a selected candidate database composed of persons registered in said registrant database whose demographics satisfy said demographic requirements.**

Column 35 line 31-40, clustering based on demographics requires an algorithm to determine how viewers are to be segmented based on demographics.

Herz teaches a registrant database as per:

Column 25 line 64-65, a registrant database of customer profiles. These customer profiles are used to reflect a customer's viewing preferences, these preferences are obtained either directly through a customer rating a program or passively based on what they watch.

Although Herz teaches clustering groups of viewers from the database based on demographics (i.e. segmenting their profiles from the database to review videos based on their demographic or other clustering characteristics), Herz does not explicitly teach creating a second database to contain the selected candidate database.

However the creation of an additional database in addition to the one stated by the claim as a duplication of parts has not been upheld as a patentably distinct limitation (In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)).

Art Unit: 3623

Regarding **Claim 7**, Herz teaches:

**the step of replacing persons the selected candidate database with other persons from said registrant database whose demographics satisfy the demographic requirements pre-established for the test screening said particular specific video whenever a person initially placed in said selected candidate database declines or fails to serve.**

As discussed above, Herz teaches using a panel of selected candidates to test screen a particular specific video. In Column 13 line 29-31, Herz teaches that the panel of experts of customers who are screening a video should be as large as possible for statistical reasons. This implies that losing a number of people from the audience would make the feedback not statistically relevant and of limited use.

Official Notice is taken that it is old and well known in the art to replace participants who fail or decline to serve on a panel so that the feedback from the missing person is replaced by a suitable alternate.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Herz, regarding having a test screening panel that is as large as possible, to include the step of replacing persons who decline or fail to serve in screening a particular video, because it would ensure the feedback from missing persons would be replaced to ensure the feedback does not lose statistical significance.

Regarding **Claim 8**, Herz teaches:

Viewers who are customers and thus have provided agreement implicitly to abide by a set of pre-established conditions (i.e. to rate a particular video).

Herz does not teach:

**the additional step of obtaining agreement by a volunteering person to abide by a set of pre-established conditions for video test screening before including such person in the registrant database.**

Von Kohorn teaches:

Paragraph 34 line 1-4, obtaining agreement from people who have agreed to participate as contestants.

Official Notice is also taken that it is old and well known in the art to obtain agreement from a volunteering person to abide by a set of pre-established conditions. This ensures that the participants acknowledge understanding of their roles and responsibilities as a volunteering person and agreement to abide by those roles and responsibilities.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Herz, regarding test screening a particular video, to include the step of obtaining agreement from participants prior to those participants being entered into a database, because it would ensure the participants understood their roles and responsibilities as a volunteering person.

Regarding **Claim 9**, Herz teaches:

**the step of predetermining the number of persons to be included in said test screening audience database before establishing said database.**

Column 6 line 6-7, the agreement matrix is calculated based on a particular number of customers from 1 to 'a'. This agreement matrix is also used in test screening of particular videos.

9. **Claims 10 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Herz US 6,088,722** in view of **Von Kohorn US 2001/0003099** and further in view of **Haithman**.

Haithman, Diane, "The new TV season Attention Shoppers: Fall TV shows are Here Networks and Retailers team up in cross-promotions to trumpet new season; but will viewers buy it?", Aug 20, 1989, Los Angeles Times, pp.1-5, ProQuest ID 66529044.

Regarding **Claim 10**, Herz teaches screen testing of videos, as discussed above. Herz also teaches that respondents to test screening do not also provide the correct or necessary responses to surveys.

Herz does not teach:



Art Unit: 3623

**the step of displaying in the video under screen testing a verification code for a limited time without advance notice to any members of the test screening audience, and the step of quizzing members of the test screening audience about said verification code, to thereby learn if any member of the test screening audience failed to view a portion of the video containing the verification code.**

However the concept of broadcasting a verification code to determine if an audience is watching a video is old and well known in the art, as evidenced by Haithman. Haithman teaches broadcasting a verification code to allow viewers who see the code to be identified as having watched a specific video. Those who do not watch the video are identified as such by not being able to cash in their game cards.

Haithman, Herz and Von Kohorn all address issues related to broadcasting, thus Haithman, Herz and Von Kohorn are all analogous art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the collective teachings of Herz and Von Kohorn, regarding providing for video screening to a test audience, to include the step of providing verification code to determine who has not watched the video, as taught by Haithman, because it would provide a way to encourage viewers to watch a particular show.

**Claim 14** recites similar limitations as those recited in **Claim 10** above, and is therefore rejected under the same rationale

**Claims 11-13 and 15** recite similar limitations as those recited in **Claims 1-9** above, and are therefore rejected under the same rationale.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Everest: Database Management, textbook published by McGraw-Hill, Inc. in 1986, page 746 (see Figure 18-3). This excerpt details the different ways that information can be stored in database management schema.

Berkman, Sue, "Sunburst creates videos to ease family tensions", Westchester Country Business Journal, Aug 1998, Vol. 37, Iss. 35, p.1, ProQuest ID 44876190.

Mullen, Megan, "The Pre-History of pay cable television: An Overview and Analysis", Mar 1999, Historical Journal of Film, Radio and Television, Vol. 19, Iss. 1, p.39, ProQuest ID 40332563.

Art Unit: 3623

"Promotion Helps Stations Interact with Audience", Aug 1990, Adweek's Marketing Week, v00, n00, p44, Dialog 01292168.

Dialog 01602602 02-53591, Online broadcasting is here, Alexander, Devon, Potentials in Marketing v31n2 PP: 10 Feb 1998.

US 5446919 by Wilkins discloses a communication system for demographically defined audiences.

US 5812642 by Leroy discloses an audience response monitor.

US 6161137 by Ogdon discloses a method for providing a presentation on a network.

US 2004/0103150 by Ogdon discloses a method and system for providing a presentation on a network (different classification).

US 4546382 by McKenna discloses a television and market research data collection system.

US 5508731 by Kohorn discloses a generation of an enlarged participatory audience for broadcasts.

US 5561708 by Remillard discloses a method for interactive television through use of menu windows.

US 5937037 by Kamel discloses a communication system for delivering promotional messages.

JP 2001060928 A by Yoshida discloses a system for surveying audience viewing rate.

Art Unit: 3623

US 2002/0059218 by August discloses a system for obtaining real time survey information from an audience using an input device.

US 5550928 by Lu discloses an audience measurement system.

US 2004/0260575 by Massey discloses a method for the sale of movies prior to the production thereof.

US 5504519 by Remillard discloses a viewer monitoring and coupon generating method for use with interactive TV.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G. Sterrett whose telephone number is 571-272-6881. The examiner can normally be reached on 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3623

JGS 9-5-2005

JES

*Susanna Diaz*

SUSANNA M. DIAZ  
PRIMARY EXAMINER

*AU 3623*